

REMARKS

By the present amendment, Applicant has amended Claims 1, 9 and 15. Claims 2, 3, 6-8, 12, 13 and 18 have been cancelled. Claims 1, 4, 5, 9-11, 14-17 and 19 remain pending in the present application. Claims 1, 9 and 15 are independent claims.

In the recent Office Action the Examiner rejected Claims 6-8 under 35 U.S.C. § 112, second paragraph, as being indefinite. The cancellation of Claims 6-8 by the present amendment serves to render these particular grounds of rejection moot.

Claims 1 and 6-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nolte (US 3,610,626). Claims 2-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte, taken alone. Claims 6-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of the Examiner's Official Notice of the conventional method of playing chess.

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

The patent to Nolte discloses a chess-like game where the size of the playing area and the number of chess figures is increased to permit simulation of a larger game, and wherein the players assist one another as allies. The board of Nolte (Fig. 1) includes a sixty-

four playing position, 8 x 8, central playing area having a checkerboard pattern, and outlying areas for setting up chessmen, to create a two, four, six or eight player game. Each set of chessmen is “distinctive” so that each player can keep track of his own figures, however, the darker colored chessmen play together as allies and the lighter colored chessmen are allies as well. The moves of the chessmen are conventional, including the pawn (Nolte, col. 3, lines 35-38).

Applicant’s Claim 1 has been amended to include the limitations of cancelled Claims 2 and 3. Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte, taken alone. The Examiner indicates that the reference to Nolte can be read to include a game board having an 18 x 18, 324 playing position central playing area, with the remaining outer spaces comprising eight initial playing extensions. The Examiner further believes that it would have been obvious to one of ordinary skill in the art to “have provided playing pieces and spaces differently colored for identification/belongingness” (Office Action, p. 3, lines 23-24). Applicant does not agree.

In this regard, while the Examiner may have interpreted the Nolte patent to read on the central playing area and initial playing extensions recited in Applicant’s amended Claim 1, there is no teaching or suggestion in Nolte to uniformly color the light colored position of the initial playing extensions, with the light colored positions of each initial playing extension colored differently from one another, and to color the playing pieces of each set of playing pieces to correspond to one of the initial playing extension colors. The chess-like game and game board of Nolte is designed to be configured in a number of different

orientations, depending on the number of players, and the type-of game intended to be played. The disclosure of Nolte does not teach or suggest the coloring of the initial playing extensions to match the playing pieces placed thereon, and to be different from the other initial playing extensions and corresponding playing pieces, because it would be an undesirable modification, and would serve no purpose, since the board and playing pieces in Nolte are initially set up in any of a variety of configurations. Thus, it would not have been obvious to modify the game board and playing pieces of the chess-like game of Nolte, in the manner urged by the Examiner, to derive Applicant's invention as recited in amended Claim 1.

Applicant's Claim 9 is drawn to a method of playing a multiple player board game, and has been amended to include the limitations of cancelled dependent Claims 12 and 13. In particular, Claim 9 now recites steps wherein pawns are selectively moved up to three positions forward on an initial move, pawns are moved up to two positions on subsequent moves, and pawns are moved one position laterally on moves subsequent to the initial move. Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of the Examiner's Official Notice of the conventional method of playing chess. With regard to Nolte, the Examiner states that "(i)n order to make the game attractive, it would have been obvious to use chess playing method steps to promote the game. One of ordinary skill in (the) art at the time the invention was made would have suggested using commonly known chess method steps for promoting a board game" (Office Action, p. 4, lines 9-12). Applicant does not agree with the Examiner's rejection.

In this regard, Applicant points out that the above-noted limitations, which have been added to Claim 9, and were formerly present in dependent claims 12 and 13, are not “commonly known chess playing method steps”, as the Examiner indicates. In the traditional game of chess, a pawn may not move three positions forward on an initial move, may not move two positions on a subsequent move, and may not move laterally at any time. Thus, it would not have been obvious to modify the playing steps of the game of Nolte, by using commonly known chess method steps “for promoting a board game”, in the manner urged by the Examiner to arrive at Applicant’s method of playing a multiple player board game as recited in amended Claim 9.

Claim 15 is drawn to a method of playing a multiple player board game, wherein eight checker sets are provided and used for playing the game. Applicant’s Claim 15 has been amended to include the limitations of cancelled dependent Claims 18. In particular, Claim 15 now recites steps wherein checkers are selectively moved up to two positions forward on any move. Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of the Examiner’s Official Notice of the conventional method of playing chess. Applicant does not agree.

Not only is amended Claim 18 drawn to a method of playing a multiple player board game, wherein checkers are used as the playing pieces, the method step of selectively moving checkers up to two positions forward on a move is neither a commonly known checkers move, nor a commonly known chess move. Thus, it would not have been obvious to modify the playing steps of the game of Nolte, by using commonly known chess playing

method steps “for promoting a board game”, in the manner urged by the Examiner, to arrive at Applicant’s method of playing a multiple player board game as recited in amended Claim 15.

Dependent Claims 10, 11, 16 and 17 depend from independent Claims 9 and 15, respectively. Claims 10, 11, 16 and 17 are believed be patentable over the patent to Nolte and the Examiner’s Official Notice of the conventional method of playing chess, for the same reasons as is set forth above regarding independent Claims 9 and 15. In addition, Claims 10, 11, 16 and 17 contain limitations similar to limitations, argued above, as rendering independent Claim 1 allowable over the prior art of record. In particular, Claims 10, 11, 16 and 17 recite the steps of providing differently colored initial playing extensions, and providing playing pieces of colors that correspond to the colors of the initial playing extensions. As is argued above, these limitations, would not be a desirable modification to the game of Nolte, and are neither taught nor suggested by Nolte or the commonly known rules of chess. Thus, for the reasons argued against the rejection of Claims 9 and 15, and additionally for the reasons argued against the rejection of Claim 1, it would not have been obvious to modify the playing steps of the game of Nolte, by using commonly known chess playing method steps, in the manner urged by the Examiner, to arrive at Applicant’s method of playing a multiple player board game as recited in Claims 10, 11, 16 and 17.

MPEP § 2143 states: “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” There is nothing in the teachings of the relied upon prior art which would have suggested the desirability, and thus the obviousness of the Examiner's modifications of the chess-like game of Nolte. It is only by impermissible hindsight and reliance on Applicant's own disclosure that the Examiner would have been led to reconstruct the chess-like game of Nolte so as to derive Applicant's claimed multiple player board game and method of playing, from the applied teachings. It is therefore Applicant's conclusion that the teachings of Nolte, either taken alone or in combination with the Examiner's Official Notice of the conventional chess playing method, fail to establish a *prima facie* case of obviousness.

The patents made of record in the present application, but not used by the Examiner in any rejection of the claims, have also been carefully reviewed, however, Applicant finds nothing therein which would overcome or supply that which is lacking in the basic combination of the other applied prior art noted above.

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The claims in this application have been revised to more particularly define Applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the above-noted reasons is respectfully requested.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Gibson". The signature is fluid and cursive, with the first name "Robert" and last name "Gibson" clearly distinguishable.

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Attachments:
Petition for Extension of Time
Check